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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
02/126,829	05/07/95	AERTO	294-02

HOFFMANN AND BARON
350 JERICHO TURNPIKE
JERICHO NY 11753

18M2/0916

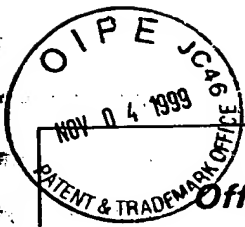
EXAMINER WHISENT, J.	
ART UNIT	PAPER NUMBER
1897	7

DATE MAILED:

09/16/96


Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents



Office Action Summary

Application No. 08/486,839	Applicant(s) Aerts, J.
Examiner Ethan C. Whisenant, PhD.	Group Art Unit 1807



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-31 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-31 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

RESTRICTION REQUIREMENT

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, 22-27, 30-31 drawn to the protein Chitinase and antibodies against Chitinase, classified in class 530, subclass 350.**
- II. Claim 15, drawn to a method of treatment using a Chitinase containing pharmaceutical, classified in class 424, subclass 130.1.**
- III. Claims 16-18, drawn to a process of preparing Chitinase, classified in class 435, subclass 70.1.**
- IV. Claims 19-21, and 28-29, drawn to nucleic acids encoding the protein Chitinase or portions thereof, classified in class 536, subclass 23.1.**

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, for example, the product can be used as an antigen to elicit an immune response.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, for example, the product can be used as a molecular weight marker in acrylamide gel electrophoresis.

Inventions I and IV are patentably distinct in structure and physicochemical properties. Invention IV is drawn to nucleic acids and invention I is drawn to proteins. Because nucleic acids are composed of nucleotides while proteins are composed of amino acids, the inventions have different structural and physical properties. Furthermore, the products of inventions I and IV are utilized in different methodologies. The products in group IV are used in hybridization-type assays whereas the proteins of group I are used as antigens to raise antibodies.

Inventions II and III are patentably distinct methods with different intermediate steps and different end results.

Inventions II and IV are related as a product and a process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, for example, the product (i.e. nucleic acids encoding the protein Chitinase or portions thereof) can be used as hybridization probes.

Inventions III and IV are patentably distinct methods with different intermediate steps and different end results.

Serial Number: 08/486,839
Art Unit: 1807

4

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. A telephone call was made to Ronald Baron on 9 SEP 96 to request an oral election to the above restriction requirement, but did not result in an election being made.
5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

CONCLUSION

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:00AM -4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Group is (703) 305-7401. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).


Serial Number: 08/486,839
Art Unit: 1807

5

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



Ethan Whisenant, Ph.D.
Patent Examiner



W. GARY JONES
SUPERVISORY PATENT EXAMINER
GROUP 1800

9/14/96